



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
087303.561	09/09/94	BEDNORZ	J Y0987074BY

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EXAMINER

MC GINTY.D

ART UNIT	PAPER NUMBER
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1105

DATE MAILED: 01/08/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/303,561

Applicant(s)

Bednorz et al.

Examiner

Douglas J. McGinty

Group Art Unit

1105



☒ Responsive to communication(s) filed on Oct 17, 1996. That communication is NON-RESPONSIVE.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 24-26, 86-90, and 96-113 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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NOTICE OF NON-RESPONSIVE AMENDMENT

1. The communication filed on October 17, 1996 is non-responsive¹ to the prior Office action because of the reasons that follow:

a. In their October 17, 1996 Amendment, paper no. 57, the applicants state, with parentheses and emphasis added:

In response to the Examiner's interview summary dated May 22, 1996, Applicant's (sic) have added claims 109-113 which correspond to independent claims 24, 86, 88, 96 and 108, respectively. The added claims read the same as these claims **but including the limitations suggested by the Examiner.**

Notwithstanding that statement by the applicants, newly added claims 109-113 do **NOT** correspond to the suggestions made by the Examiner as documented in the Interview Summary dated May 22, 1996, paper no. 55.

i. That Interview Summary states, with emphasis added:

To overcome 112 1st para, rejections, it is suggested that each independent claim be amended to require at least one **each** of a IIA metal, a rare earth or IIIB metal, and copper oxide.

ii. Newly amended claims 109-113 do not "require at least one **each** of a IIA metal, a rare earth or IIIB metal, and copper oxide" (emphasis added). Instead, for instance, claim 109 only requires that "said copper oxide includes at least one element **selected from the group consisting of** a Group II A element, a rare earth element and a Group IIIB element" (emphasis added)." Claims 110-113 each have similar Markush groupings for the II A, rare earth, and III B elements.

¹See MPEP 714.02-714.04.

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- b. The October 17, 1996 Amendment, paper no. 57, the applicants further assert: Claims 24-26, 86-90 and 96-108 have been rejected for essentially the same reasons as in the Office Action dated March 29, 1995. Applicant's (sic) respectfully disagree for the same reasons given in Applicants (sic) response dated September 26, 1995, October 10, 1995 and April 11, 1996, which Applicant's (sic) incorporate herein by reference.

General assertions of patentability are not deemed to be responsive.²

2. To be responsive, an amendment must include the following:

a. One or the other approach with respect to newly added claims 109-113:

i. Pursuant to the May 21, 1996 interview, each of claims 109-113 may be amended to recite compositions containing **THREE** components:

- (1) a II A metal;
- (2) a rare earth or III B metal; **AND**
- (3) a copper oxide.

ii. As an alternative, claims 109-113 in their present form may be accompanied by particular arguments to the effect that the same amendments overcome the 35 USC 112 rejections in the previous Office Action.³

b. Arguments directed to the particular points raised in the April 15, 1996 Office Action, paper no. 54, with respect to the rejections under 35 USC 112, 102, and 103.

3. Since the response appears to be *bona fide*, but through an apparent oversight or inadvertence failed to provide a complete response, applicant is required to complete the response within a TIME LIMIT of **ONE MONTH** from the date of this letter or within the time remaining in the response period of the last Office action, whichever is longer. **NO EXTENSION OF THIS**

²See 37 CFR 1.111(b).

³Each of claims 109-113 still needs to be reviewed for compliance with 35 USC 112 and examined with respect to 35 USC 102 and 103.

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TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b), but the period for response set in the last office action may be extended up to a maximum of SIX MONTHS.

Conclusion

4. Any amendment in response to this Office Action must NOT include any new matter.
5. The applicant or applicants is or are reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J. McGinty, whose telephone number is (703) 308-3805. The examiner normally can be reached on Monday through Friday from 8:30 A.M. to 5:00 P.M., Eastern time. If *reasonable* attempts to reach the examiner by telephone are unsuccessful, however, the examiner's supervisor, Mr. Paul Lieberman, can be reached at (703) 308-2523. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661. The fax number for this Group is (703) 305-3600.

January 3, 1996
303561.3

Douglas J. McGinty
Douglas J. McGinty
Primary Examiner
Group 1100